

S/N 10/763,625

Response to Office Action Dated 14 August 2006

REMARKS**RECEIVED
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1 A review of the claims indicates that:

2 A) Claims 1—37 and 39 are cancelled.

3 B) Claims 38 and 40—42 are currently rejected.

4 C) Claims 43—58 are withdrawn.

5 The Applicant respectfully traverses the Restriction Requirement, and
6 respectfully requests allowance of the rejected claims.
7

Restriction

8 The Office has restricted claim sets 43—47 and 48—58. In response, the
9 Applicant respectfully traverses the Restriction.
10

11 M.P.E.P. § 803 states that an application may be properly restricted only if
12 (1) the inventions are independent or distinct as claimed, and (2) there is a serious
13 burden on the Examiner if restriction is not required. Thus, even if appropriate
14 reasons exist for requiring restriction, such a requirement should not be made
15 unless there is an undue burden on the Examiner to examine all of the claims in a
16 single application.
17

18 Similarities between the search required for examination of Claims 38 and
19 43, in particular, indicate that “a serious burden on the Examiner” from
20 examination of both claims would *not* result.
21

22 The Examiner’s attention is directed to the preamble and first paragraph of
23 Claims 38 and 43. Independent Claim 38 recites “a coated substrate” (see Claim
24 38, preamble). Independent Claim 43 recites “a substrate coated” (see Claim 43,
25

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1 first paragraph). Thus, the claims recite, "a coated substrate" (Claim 38) and "a
2 substrate coated" (Claim 43). Accordingly, there is a great deal of overlap
3 between the searches required for examination of independent Claims 38 and 43.
4 This weighs in favor of examination of both claim sets.

5 Similarly, paragraphs two and three of Claims 37 and 43 indicate that
6 undue burden would not result from examination of both claim sets. In paragraphs
7 2 and 3 of Claim 43, two "wherein clauses" refine the coated substrate recited by
8 the first paragraph. These two paragraphs have elements of similarity with the last
9 two paragraphs of Claim 38. Thus, Claims 38 and 43 recite "a coated substrate"
10 and a "substrate coated", followed by two final paragraphs that would require
11 similar searches. The Examiner is also urged to compare the final two paragraphs
12 of Claims 38 and 43.
13

14 Thus, the Applicant urgently requests that the Examiner look at Claim 38
15 and Claim 43 in a side-by-side comparison. The Applicant submits that
16 similarities between the search requirements for examination of these claims
17 indicate that the Restriction Requirement is not warranted.
18

19 Accordingly, the Applicant urgently submits that, at a minimum, claims
20 associated with both independent Claim 38 and Claim 43 be examined.
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Traversal of Rejection of Independent Claim 38

Claim 38 recites, as amended, a coated substrate configured for printing a toner image thereon, comprising comprising:

- a paper substrate;
- an underlayer coating, applied directly on the substrate, wherein the underlayer coating comprises amine terminated polyamide; and
- an overlayer coating, applied directly on the underlayer coating, comprising a polymer material to which the toner image can be fused and fixed.

Claim 38 has been amended to recite, "a paper substrate." This limitation was seen in the Original Claim 5. Original Claim 5 was rejected in a single-reference Section 103(a) rejection as being unpatentable over Lever (see Office Action mailed 06/15/2006). However, in making out the rejection, the elements of Claim 5, including the paper substrate, were not addressed individually. Instead, Claim 5 was addressed en mass with Claims 1—30. The Applicant respectfully traverses the rejection Claim 38, also reciting a "paper substrate".

A thorough review of the Lever reference reveals that it does not disclose, teach or suggest a paper substrate having the underlayer and overlayer, as recited by original Claim 5 and current Claim 38.

In making out the rejection of Claim 5, and by extension current Claim 38, the Patent Office appears to suggest that the terms "film" or "sheet," recited by the Lever reference, teach a paper substrate. The Applicant respectfully disagrees.

First, the Applicant submits that Lever does not actually disclose the term "sheet." A search of the document does not reveal this term.

The Lever reference does disclose the term "film" in several locations. However, the Applicant submits that the term "film" does not teach or suggest "paper." In fact, Lever uses this term to refer to a polymeric material (e.g. see

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1 page 2, line 23). Accordingly, Lever does not teach or suggest an element recited
2 by the claim, and the Lever reference is deficient to support the Section 103
3 rejection of Claim 38.

4 Moreover, absent *at least* a showing that Lever's lacquer layer would
5 adequately adhere to a paper substrate, a *prima facie* showing has not been made
6 that the teachings of Lever are combinable with a paper substrate.

7 As it stands, the Applicant submits that Lever does not teach or suggest a
8 paper substrate, as was recited by Original Claim 5 and Current Claim 38.
9 Moreover, no motivation to combine the teachings of Lever with a paper substrate
10 has been set forth, and no showing that Lever's lacquer would adhere to paper has
11 been made.

12 Therefore, the Applicant submits that the Lever reference does not support
13 the Section 103(a) rejection. Accordingly, the Applicant respectfully requests that
14 the Section 103 rejection be removed.

15
16 **Traversal of Rejection of Claims 40—42**

17 Claims 40—42 depend from Claim 38 and are allowable due to their
18 dependence from an allowable base claim. These claims are also allowable for
19 their own recited features that, in combination with those recited in Claim 38, are
20 not shown and not disclosed in references of record, either singly or in
21 combination with one another.

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Conclusion

The Applicant submits that all of the claims are in condition for allowance and respectfully requests that a Notice of Allowability be issued. If the Office's next anticipated action is not the issuance of a Notice of Allowability, the Applicant respectfully requests that the undersigned attorney be contacted for scheduling an interview.

Respectfully Submitted,

Dated: 14 Nov 2006By: 

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